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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Howard Dernehl

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HAVERSTOCK & OWENS LLP
162 N WOLFE ROAD
SUNNYVALE, CA 94086

EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

12/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/635,994	Applicant(s) DERNEHL ET AL.	
	Examiner Raquel Alvarez	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/13/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,12,13,15-21,23,27-30,34-36,40,41 and 43-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,12,13,15-21,23,27-30,34-36,40,41 and 43-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/19/2010, 11/23/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 9/13/2010.
2. Claims 1-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41 and 43-56 are presented for examination.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 46 and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims call for selectively offering a reward to the second party, by the Service Provider, in exchange for the second party recommending the marketable entity to a third party, independent of whether the second party purchases the marketable entity. The specification on page 15 describes the second party receiving a reward for the third party conducting a transaction but doesn't describe the second party receiving a reward even if the third party doesn't consummate a purchase. Correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 46-49 are rejected under 35 USC 101 because the establishing step is not central to the purpose of the method, therefore is insignificant extra-solution activity. Applicant is advised to add a computer to the steps of offering, providing of the reward.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1-4, 6-10, 13, 15-21, 23, 27-30, 34-36, 40-41 and 43-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over article titled "Argos Business Solutions: Customer Referral Scheme Encourages Sales of Mobile Phones" Argos Business Solutions over article titled, "recommend-it.com" further in view of f "How MileNet Works" hereinafter MileNet.

With respect to claims 1-4, 7-10, 12-13, 15-16, 19, 27, 40-41, 46-51 Argos Business Solutions teaches a method of marketing (entire document). providing a referral-based service and one or more marketable entities to be purchased, wherein the referral-based service and the one or more marketable services are provided by a Service Provider and any purchase transaction of one of the one or more marketable entities is performed by the Service Provider (i.e. existing customers refer colleagues, friends or family to purchase a new mobile phone and the existing customers receive points)(page 1, paragraph 3);

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offering a reward to the first party by the Service Provider in response to the first party purchasing the marketable entity, the reward is in exchange for a recommendation that results in a purchase of the marketable entity by a second party (i.e. existing customers collect points for purchases made by the referee (page 1, paragraph 3);

correlating data within a database, the data within the database comprising data relating to the reward offered to the first party and providing the reward to the first party if the second party purchases the marketable entity (i.e. database of quality branded items such as sports goods, children's toys and garden equipment are provided to the existing customers for purchases made by the referee)(page 2, paragraph 1); the recommendation being selected from a group consisting of goods and services (i.e. various purchases by the referee qualifies the existing customer to receive points)(page 1, paragraph 3).

Argos doesn't specifically teach personalizing the referral of the marketable entity (i.e. mobile phone) including a serial number for the marketable entity (i.e. mobile phone). Official Notice is taken that serial numbers are unique letters and numbers that are used for identification of a product, hardware or software. It would have been obvious to a person of ordinary skill in the art at the time of have included in Argos personalizing the referral by providing to the referee the serial number of the marketable entity (mobile phone) in order to uniquely and unequivocally identify the marketable entity (i.e. mobile phone).

Argos Business Solutions doesn't specifically teach sending the recommendation via an e-mail message to the second party including an URL link to the web site of the service provider and updating the database with the e-mail address of the second party and relating the e-mail address of the second party, within the database, to the first set of data in the first email message, thereby creating a referral lineage. Recommend-it.com teaches the first user will send an e-mail to a friend or colleague detailing the site and would include a short description identifying advertisements)(page 2); correlating the first set of data in the first e-mail message to data within a database (page 2); updating the database with an e-mail address of a second party provided by the first party (pages 1-4); forwarding the first e-mail message to the e-mail address of the second party and relating the e-mail address of the second party, within the database, to the first set of data in the first email message, thereby creating a referral lineage (see page 4). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the invention of Argos Business Solutions the teachings of recommend-it.com of sending the recommendation via an e-mail message to the second party comprising a personalized referral for the marketable entity including an URL link to the web site of the service provider and updating the database with the e-mail address of the second party because such a modification would allow the second party the convenience of using his or her computer to viewed all the details of the items recommended.

With respect to the newly amended feature of selectively offering a reward to the second party, by the Service Provider, in exchange for the second party recommending

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the marketable entity to a third party, independent of whether the second party purchases the marketable entity. MileNet teaches a pyramid type of incentives wherein the first party receive points for referring a second person and the second person receives points for recommending a third person without having to make a purchase. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the combination of Argos and Recommend-it the teachings of Milenet of selectively offering a reward to the second party, by the Service Provider, in exchange for the second party recommending the marketable entity to a third party, independent of whether the second party purchases the marketable entity because such a modification would allow the parties for benefiting from the recommendation itself regardless if the recommended party makes a purchase or not.

Claims 6, 17-18, 20, further recite that the link is accessible through a token in the form of a first icon visible in the message. Official notice is taken that it is old and well known in the computer related field to have a token in the form of an icon that is visible in the message in order to represent a function, object or program. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a token in the form of a first icon visible in the message in order to make file navigations and manipulation easier.

Claims 23, 28-30, 34-36, 43-45 further recite crediting an account within a database and recording the reward credited. Official notice is taken that it is old and well known in the business related arts to credit an account because such a modification would provide an easy and efficient way to reward a customer. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included crediting an account within a database and recording the reward credited in order to obtain the above mentioned advantage.

Claim 52 further recites before providing a referral based service, evaluating application to determine suitability of goods and services in the referral based service. Official Notice is taken that it is old and well known to evaluate and determine what items or goods and services are going to be provided before the referral service is provided in order to determine ahead of time and plan for the suitable items, goods or services. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included before providing a referral based service, evaluating application to determine suitability of goods and services in the referral based service in order to obtain the above mentioned advantages.

Claims 53-56 further recite using a third party system such as an analysis system, policy management system for determining the cost value of the reward offered. Official Notice is taken that it is old and well known to use and delegate responsibilities to a third party. It would have been obvious to a person of ordinary skill

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in the art at the time of Applicant's invention to have included using a third party system such as an analysis system, policy management system for determining the cost value of the reward offered in order to obtain the above mentioned advantage.

Response to Arguments

9. Applicant's arguments filed 9/13/2010 have been fully considered but they are not persuasive.

10. Applicant argues that Argos and Recommend-it don't teach personalizing the referral of the marketable entity and that the provided facts is gleaned from the prior art in support of the conclusion of obviousness. The Examiner respectfully disagrees with Applicant because the Official Notice taken pertaining to personalizing the marketable entity (i.e. mobile phone) takes into account knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. Applicant argues that that the combination of Argos and Recommend-it is improper because the references teach away from one another with respect to incentives because Argos teaches offering an incentive for a referral. To obtain the incentive, a first party must (1) make a purchase of some product sold by DX and that in Recommend-it states that it is "100% Free". The Examiner wants to point out that Recommend-it.com was cited merely for the teachings of sending an URL link via an e-

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mail and relating the e-mail address of the second party, within the database, to the first set of data in the first email message, thereby creating a referral lineage. In addition, the Examiner wants to point out that Argos does not discourage "incentives for referrals that do not result in purchases" as required for a teaching away. *See In re Gurley*, 27 F.3d 551,553 (Fed. Cir. 1994) (a reference may be said to teach away when a person of ordinary skill, upon examining the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant). Indeed, Argos is silent on the issue, which would rule out discouragement.

Applicant argues that the combination of Argos and Recommend-it do not teach offering a reward to the first party for a recommendation to a second party regarding the marketable entity that results in the purchase of the marketable entity. The examiner disagrees with Applicant because Argos teaches clearly teaches existing customers collect points for purchases made by the referee (see page 1, paragraph 3)

12. Applicant argues that Argos and Recommend-it do not teach correlating the first set of data in the first e-mail message to data within a database, comprising data related to the reward offer to the first party, the reward offered to the first party, the marketable entity, and the second party thereby creating a referral lineage. Recommend-it teaches the first user will send an e-mail to a friend or colleague detailing the site and would include a short description identifying advertisements (page 2) then the following parties sending the e-mail to other parties therefore creating a referral lineage between the

parties in addition Milenet teaches a pyramid type of incentives where the parties are incentivized for recommending other parties.

13. With respect to Applicant's arguments pertaining to "selectively offering a reward to the second party, by the Service Provider, in exchange for the second party recommending the marketable entity to a third party, independent of whether the second party purchases the marketable entity" arguments are moot, new grounds of rejection.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
12/15/2010